

## **REMARKS/ARGUMENTS**

Claims 1-13 and 15 are pending in the present application. Claims 1, 5, 8, 10 and 15 are amended. Claim 14 is canceled. Support for amendments to claim 1 may be found in the drawings of record in Figure 1, reference numeral 103, Figure 2, reference numeral 205, as well as in the description on page 16, lines 26-28. Support for amendments to claims 5, 8, 10 and 15 may be found in the respective claims. Additional support for amendment to claim 15 may be found in the description on page 7, line 17 through page 8, line 2. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 102, Anticipation: Claims 1, 4-13, 15**

The examiner rejected claims 1, 4-13, and 15 under 35 U.S.C. § 102 as anticipated by *Paul*, Apparatus and method for controlling delivery of unsolicited electronic mail, U.S. Patent 6,052,709, (April 18, 2000), (hereinafter “*Paul*”). This rejection is respectfully traversed. The examiner states:

As per claim 1, *Paul* teaches a computerized method for improved handling of messages directed to an user of an electronic messaging system (col.1, lines 50-60): determining user characteristics capable of identifying said user as addressee of a message(col.5, lines 10-15);

analyzing a certain message and determining its message characteristics from one or a multitude of message fields(col.6, lines 1-15); and

applying at least one deduction rule of a potential set of deduction rules to said certain message, which assigns based on said user characteristics and said message characteristics a role of said user to said certain message said role revealing said user's relationship to said certain message(col.6, lines 1-43).

Final Office Action dated November 8, 2007.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Claim 1, as currently amended, is as follows:

A computerized method for improved handling of messages directed to a user of an electronic messaging system, said method comprising:

determining user characteristics capable of identifying said user as addressee of a message;

analyzing a certain message and determining its message characteristics of said certain message from one or a multitude of message fields;

selectively applying at least one deduction rule of a potential set of deduction rules, based on said user characteristics and said message characteristics, to said certain message; and

responsive to selectively applying at least one deduction rule, said at least one deduction rule identifying a role of said user and assigning said role to said certain message, said role revealing a relationship of said user to said certain message.

Claim 1, as amended, is not anticipated by *Paul* because *Paul* does not teach or suggest every element of the claimed invention. Specifically, *Paul* does not teach the claimed features of, “selectively applying at least one deduction rule of a potential set of deduction rules, based on said user characteristics and said message characteristics, to said certain message” and “responsive to selectively applying at least one deduction rule, said at least one deduction rule identifying a role of said user and assigning said role to said certain message, said role revealing a said user's relationship of said user to said certain message.” The examiner asserts otherwise and cites various portions of *Paul*.

**I.i** Regarding the feature of, “selectively applying at least one deduction rule of a potential set of deduction rules, based on said user characteristics and said message characteristics, to said certain message,” the examiner believes the following portion of *Paul* teaches this claimed feature:

The user exclusion lists preferably includes all identification data needed to determine the status of incoming e-mail messages. Data in the exclusion list may be divided into categories corresponding to the fields of incoming e-mail messages as illustrated in FIG. 3. For example, filtering using the "FROM" category of the exclusion list may be sufficient to control delivery of spam messages. However, users and/or service providers may optionally implement filtering based upon additional exclusion list categories, such as the "TO", "BCC," "CC," and "SUBJECT" e-mail headers and other headers. Filtering may also be based on the contents in the body of the email. The user exclusion list may be automatically created and maintained and/or created and modified manually by the user or service provider. The user terminal may also perform filtering based upon filtering instructions received from the control center 101.

In the preferred embodiment depicted in FIG. 4, alert signals received from the control center 101 are automatically processed by the filtering application so that

the source data extracted from the alert signals are automatically added to the stored exclusion list. Thus, source data detected by the spam probe, processed by the control center 101, and transmitted in the alert signals are used to automatically update the filtering applications in the user terminals 130-138.

The user terminal filtering application in the preferred embodiment depicted in FIG. 2 further includes an e-mail storage database 206, which receives and stores incoming e-mail and stores records of outgoing e-mail. An e-mail filter 204 filters the incoming e-mail stored in store 206 in accordance with the user exclusion list stored in database 202. A user interface 208 is provided to receive inputs from the user and to display e-mail information to the user. The user interface 208 may be implemented, for example, using an e-mail software package known in the art, such as Netscape.RTM. Messenger.RTM., Microsoft.RTM. Outlook.RTM., Microsoft.RTM. Exchange.RTM., Lotus.RTM. cc: mail.RTM., Lotus Notes.RTM., Novell.RTM. Groupwise.RTM., Eudora.RTM., or America OnLine.RTM.. User interface 208 may be used to display a user's mailbox, receive and process e-mail messages and inputs from the user, manage the user's mailbox, display mailbox management information to enable the user to manage the mailbox, and perform other functions as are known in the art.

*Paul*, col. 6 lines 1-43.

*Paul* is directed toward handling unsolicited electronic mail, "spam mail," as in an "apparatus and method for controlling delivery of unsolicited electronic mail." *Paul*, title. Further *Paul* does not analyze an individual user's messages to determine a user's characteristics. *Paul* teaches use of "spam probe e-mail addresses" to determine spam sites and analyze email received by the spam probes to determine email spam filters. Specifically, as shown below, *Paul* teaches that the filters are used to discard email determined to be spam as in the flowing portion:

In a system and method and system for controlling delivery of *unsolicited electronic mail messages*, one or more *spam probe e-mail addresses are created and planted at various sites* on the communications network in order to insure their inclusion on large-scale electronic junk mail ("spam") mailing lists. The mailboxes corresponding to the *spam probe e-mail addresses are monitored for incoming mail by a spam control center*. Upon receipt of incoming mail addressed to the spam probe addresses, the spam control center automatically analyzes the received spam e-mail to identify the source of the message, extracts the spam source data from the message, and generates an alert signal containing the spam source data. This alert signal is broadcast to all network servers and/or all user terminals within the communications network. A filtering system implemented at the servers and/or user terminals receives the alert signal, updates stored filtering data using the spam source data retrieved from the alert signal, and controls delivery of subsequently-received e-mail messages received from the identified spam source. The filtering system controls delivery of the unsolicited e-mail messages by *discarding the messages without displaying them to the user, displaying the messages to the user with a "JUNK" or similar marker*, or otherwise processing the *spam mail* as desired by the network provider and/or

the network users. The filtering system may also filter e-mail messages sent by the user terminals.

*Paul* abstract (emphasis provided).

In contrast, the claimed feature applies a deduction rule "...based on said user characteristics and said message characteristics, to said certain message..." Therefore, the deduction rule has information specific to the user, who will receive the message and the characteristics of the individual message. *Paul* fails to teach the claimed feature; instead, *Paul* teaches "spam probe e-mail addresses" to obtain information about unsolicited electronic mail messages. The "spam probe"-based unsolicited message of *Paul* is therefore not the same as the certain message "directed to a user of an electronic messaging system," as currently claimed.

**I.ii** Additionally, *Paul* does not teach the feature of, "responsive to selectively applying at least one deduction rule, said at least one deduction rule identifying a role of said user and assigning said role to said certain message, said role revealing a said user's relationship of said user to said certain message." Nevertheless, the examiner believes the above portion of *Paul* teaches the claimed feature. Further, the examiner opines that *Paul* teaches that being a recipient is a role and states "that being a recipient, as opposed to a sender, of an email as a "role of said user to said message." (Office Action dated November 8, 2007, page 80)

However, *Paul* fails to teach "identifying a role of said user and assigning said role to said certain message," because the role in *Paul*, as asserted by the examiner, is always defined to be the "recipient." If the recipient in *Paul* was a role, as opined by the examiner, then *Paul* does not teach having "said at least one deduction rule identifying a role of said user" of the user as claimed. *Paul*, teaches filtering email, but does not teach filters assigning a role to the user. Further, *Paul* does not assign a role of the user to the message, as claimed.

*Paul* further teaches, "discarding the messages without displaying them to the user, displaying the messages to the user with a "JUNK,"" as shown above, in order to eliminate the email. However, the claimed feature does not discard mail at all. The claimed feature aids the user by "...revealing a relationship of said user to said certain message," which is opposed to the teaching of *Paul* to discard messages. Accordingly, again, *Paul* does not teach the claimed feature at issue.

Therefore, *Paul* does not teach or suggest the claimed feature at issue. Accordingly, under the standard of *In re Bond*, *Paul* does not anticipate claim 1.

The remaining claims all contain features similar to those presented in claim 1. Hence, *Paul* does not anticipate any of the claims. Therefore, the rejection of claims 1-13 and 15 under 35 U.S.C. § 102 has been overcome.

## II. 35 U.S.C. § 103, Obviousness

The examiner rejected claims 2 and 3 under 35 U.S.C. § 103 as obvious over *Paul*. This rejection is respectfully traversed. In setting forth the rejection of claims 2 and 3, the examiner states:

As per claims 2, 3 Paul explicitly teaches the computerized method for improved handling of messages according to claim 1, wherein said user characteristics at least comprise one of the following elements:

a user ID of said user in said messaging system; a name of said user; a nickname of said user(col.5, lines 10-45); and wherein said message characteristics at least comprise one of the following elements: the contents of a TO: field; the contents of a CC: field, identifying addressees receiving a complimentary copy; the contents of a BCC: field, identifying addressees receiving a blind carbon copy; the contents of the body of said message(col.6, lines 1-44).

Paul, however does not explicitly teach wherein said set of deduction rules comprises at least one of the following deduction rules: first deduction rule, which assigns a role of SINGLE-ADDRESSEE, if said user is the only addressee in said TO: field; second deduction rule, which assigns a role of MULTIPLE-ADDRESSEES, if said user is one of a multitude of addressees in said TO: field; third deduction rule, which assigns a role of SINGLE-CC-ADDRESSEE, if said user is the only addressee in said CC: field; fourth deduction rule, which assigns a role of MULTIPLE-CC-ADDRESSEES, if said user is one of a multitude of addressees in said CC: field; fifth deduction rule, which assigns a role of BCC-ADDRESSEE, if said user is an addressee in said BCC: field; sixth deduction rule, which assigns a role of DISTRIBUTION-LIST, if said user is a member of a distribution list in said TO: field, seventh deduction rule, which assigns a role of DISTRIBUTION-LIST, if said user is the only or one of a multitude of addressees in said TO: field but said message does not contain a salutation with said user's name or nickname; eighth deduction rule, which assigns a role of DISTRIBUTION-LIST, if said user is the only or one of a multitude of addressees in said TO: field and if said message comprises a footer and said footer does not comprise information referring to a person or entity said user has an established relationship with; ninth deduction rule, which assigns a role of SINGLE-ADDRESSEE or a role of MULTIPLE-ADDRESSEES respectively, if said user is the only one or one of a multitude of addressees respectively in said CC: field but said message comprises a salutation with said user's name or nickname.

Paul does teach analyzing emails by checking header fields and/or the body message and if the message match data stored in the corresponding data category of the exclusion list manager, then the email is marked indicating "JUNK"(col.6, lines 26-58).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Paul to include filtering rules to check for single or multiple address and labeling emails since Paul does teach checking header fields and labeling email as "JUNK" in order to reduce the amount of emails that goes to the In box (Fig. 5).

One ordinary skill in the art at the time of the invention would have been motivated to modify the teachings of Paul to include filtering based on different types of header fields in order to improve the process of determining SPAM emails.

Final Office Action dated November 8, 2007, pp 5-7.

With regard to claim 2, claim 2 as previously presented, is as follows:

The computerized method for improved handling of messages according to claim 1, wherein said user characteristics at least comprise one of the following elements: a user ID of said user in said messaging system; a name of said user; a nickname of said user; and wherein said message characteristics at least comprise one of the following elements: a contents of a TO: field; a contents of a CC: field, identifying addressees receiving a complimentary copy; a contents of a BCC: field, identifying addressees receiving a blind carbon copy; the a contents of the a body of said message; and wherein said set of deduction rules comprises at least one of the following deduction rules: a first deduction rule, which assigns a role of SINGLE-ADDRESSEE, if said user is the only addressee in said TO: field; a second deduction rule, which assigns a role of MULTIPLE-ADDRESSEES, if said user is one of a multitude of addressees in said TO: field; a third deduction rule, which assigns a role of SINGLE-CC-ADDRESSEE, if said user is the only addressee in said CC: field; a fourth deduction rule, which assigns a role of MULTIPLE-CC-ADDRESSEES, if said user is one of a multitude of addressees in said CC: field; a fifth deduction rule, which assigns a role of BCC-ADDRESSEE, if said user is an addressee in said BCC: field; a sixth deduction rule, which assigns a role of DISTRIBUTION-LIST, if said user is a member of a distribution list in said TO: field.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Claim 2 depends from claim 1. As shown above, *Paul* does not teach all of the claimed features of claim 1. The examiner acknowledges that *Paul* does not explicitly teach the set of deduction rules comprising at least one of the following deduction rules wherein a rule assigns a role, as stated:

“Paul, however does not explicitly teach wherein said set of deduction rules comprises at least one of the following deduction rules,” (Final Office Action, November 8, 2007 pp 5-6).

Further, as shown previously, *Paul* does not teach identification and assignment of a role as in “a first deduction rule, which assigns a role of SINGLE-ADDRESSEE, if said user is the only addressee in said TO: field” of the claimed feature.

Nevertheless, the examiner further opines:

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Paul to include filtering rules to check for single or multiple address and labeling emails since Paul does teach checking header fields and labeling email as "JUNK" in order to reduce the amount of emails that goes to the In box (Fig. 5).

One ordinary skill in the art at the time of the invention would have been motivated to modify the teachings of Paul to include filtering based on different types of header fields in order to improve the process of determining SPAM emails.

Final Office Action dated November 8, 2007, page 7.

However, *Paul* teaches a filtering technique. In contrast, the claimed feature does not filter to “reduce the amount of emails that goes to the inbox,” as opined by the examiner. The purpose and operation of the teaching of *Paul* is directed toward solving a different problem related to unsolicited email, and therefore provides a different solution. The solution of *Paul* is directed to an improved process of determining SPAM emails, in contrast to the claimed feature of assigning a role, from among many roles, to a message to allow the user receiving the message to handle the message better. Therefore, *Paul* fails to teach or suggest the claimed features of claim 2. *Paul* fails to teach the identification and assignment of a role, based on a user to a message, as claimed. Claim 3 has similar claimed features, and is therefore also distinguished from the teaching of *Paul*.

Under the standard *In re Royka*, the prior art reference (or references when combined) must teach or suggest all the claim limitations. As shown above, the combination of references, considered as a whole, do not teach all of the features of the claims. Therefore the examiner has failed to establish a *prima facie* case of obviousness against the claims. Therefore, the rejection of claims 2 and 3 under 35 U.S.C. § 103 has been overcome.

Additionally, the examiner failed to state a *prima facie* obviousness rejection against claim 2 because the examiner failed to state a proper reason to combine the references under the standards of *KSR*

*Int'l.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Regarding a reason to combine the references, the examiner states that, "one of ordinary skill in the art at the time of the invention would have been motivated to modify the teachings of *Paul* to include filtering based on different types of header fields in order to improve the process of determining SPAM emails." However, this reason is not a rational underpinning to support the legal conclusion of obviousness of claim 2 in view of the combination of the references considered as a whole. As a first matter, as shown above, *Paul* teaches filtering of SPAM email by removing the email. As a second matter, the claimed features do not remove email; rather the email is categorized for the user. As a third matter, *Paul* teaches elimination of SPAM email. Instead, the invention of claim 2 leaves the email destined for the user, but provides additional information according to the role identified and assigned.

The elimination of SPAM email as taught by *Paul*, is irrelevant to the invention of claim 2. Therefore, the examiner's statement does not provide a rational underpinning to support the legal conclusion of obviousness, as required by *KSR Int'l.* Accordingly, under standards of *KSR Int'l.*, the examiner failed to state a *prima facie* obviousness rejection against claim 2.

### **III. Conclusion**

The subject application is patentable over the cited references and should now be in condition for allowance. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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